

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 11-21 are currently pending. Claims 11, 13, 14, 18, and 21 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.¹

In the outstanding Office Action, Claim 11 was rejected under 35 U.S.C. § 112, second paragraph, regarding a question of definiteness; Claims 11 and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0097563 to Moroney et al. (hereinafter “the ‘563 application”); Claims 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘563 application in view of U.S. Patent Application Publication No. 2002/0051539 to Okimoto et al. (hereinafter “the ‘539 application”); and Claims 15-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘563 application in view of U.S. Patent No. 5,748,732 to Le Berre et al. (hereinafter “the ‘732 patent”).

REJECTION UNDER 35 U.S.C. § 112

Regarding the rejection of Claim 11 under 35 U.S.C. § 112, second paragraph, Claim 11 has been amended to address the informalities noted in the Office Action. In particular, Claim 11 has been amended to recite, *inter alia*, checking whether the first secret code S_m is in a biunique relationship with the second secret code S_s , and to further recite authorizing and prohibiting steps. Accordingly, the rejection of Claim 11 under 35 U.S.C. § 112, second paragraph, is believed to have been overcome.

¹ See, e.g., page 8, line 30 to page 9, line 27 of the originally filed specification.

REJECTION UNDER 35 U.S.C. § 102

Amended Claim 11 is directed to a method for distribution of scrambled data and/or services to at least one master terminal and to at least one slave terminal linked with the master terminal, the method comprising:

transmitting by a central management module to the master terminal a first secret code S_m and transmitting by the central management module to each slave terminal a second secret code S_s ;

storing the first secret code S_m in the master terminal and the second secret code S_s in each slave terminal and,

for each use of a slave terminal by a user,

checking whether the first secret code S_m has previously been stored in the slave terminal,

when the first secret code S_m has previously been stored in the slave terminal,

checking whether the first secret code S_m is in a biunique relationship with the second secret code S_s ,

when the first secret code S_m has not previously been stored in the slave terminal,

inviting said user to enter the first secret code S_m in said slave terminal, and

checking whether the first secret code S_m entered by the user in the slave terminal is in a biunique relationship with the second secret code S_s ,

authorizing the reception of the scrambled data and/or services by the slave terminal, when the first secret code S_m is in a biunique relationship with the second secret code S_s , and

prohibiting the reception of the scrambled data and/or services by the slave terminal, when the first secret code S_m is not in a biunique relationship with the second secret code S_s .

Regarding the rejection of Claim 11 under 35 U.S.C. § 102(e), the ‘563 application is directed to a method and system for providing security within multiple set-top boxes assigned for a single customer. In particular, the ‘563 application discusses a method for securely

providing multiple set-top boxes for use by a single customer while preventing the unauthorized use of a secondary set-top box by another party.²

The Office Action apparently cites the ‘563 unit key and authentication key for teaching secret codes.³ However, it is respectfully submitted that the ‘563 application fails to disclose checking whether the first secret code S_m has previously been stored in the slave terminal, when the first secret code S_m has previously been stored in the slave terminal, checking whether the first secret code S_m is in a biunique relationship with the second secret code S_s, when the first secret code S_m has not previously been stored in the slave terminal, inviting said user to enter the first secret code S_m in said slave terminal, and checking whether the first secret code S_m entered by the user in the slave terminal is in a biunique relationship with the second secret code S_s, authorizing the reception of the scrambled data and/or services by the slave terminal, when the first secret code S_m is in a biunique relationship with the second secret code S_s, and prohibiting the reception of the scrambled data and/or services by the slave terminal, when the first secret code S_m is not in a biunique relationship with the second secret code S_s. Rather, the ‘563 application simply discusses that a slave box is linked to a master box with a physical communication link so that if the physical link is severed, e.g., if an attempt is made to move the slave box to another household to provide unauthorized service in that household, the slave box is programmed to stop working when it can no longer communicate with the master box.⁴ Further, with respect to the cited unit and authentication keys, the ‘563 application simply discusses that the unit key is used for reconfiguration, and the authentication key is shared between a master-slave pair to verify that they have not been separated.⁵ The ‘563 application does not disclose that the detection

² See ‘563 application, paragraph [0001].

³ See Office Action dated April 13, 2009, page 3.

⁴ See ‘563 application, paragraph [0018].

⁵ Id. at paragraph [0031].

of whether a physical link is severed or the use of unit and authentication keys involve checking, inviting, authorizing, and prohibiting steps, as defined in Claim 11.

Accordingly, it is respectfully submitted that Claim 11 (and all associated dependent claims) patentably defines over the ‘563 application.

REJECTION UNDER 35 U.S.C. § 103

Regarding the rejections of dependent Claims 12-14 under 35 U.S.C. § 103(a), it is respectfully submitted that the ‘539 application fails to remedy the deficiencies of the ‘563 application, as discussed above.

The ‘539 application is directed to the problem of securing the generation process of ECM. As described at page 2, paragraphs [0021-0022], the ‘539 system includes an encryption renewal system (ERS) for performing an operation called ECM (entitlement control message) retrofitting to keep pre-encrypted contents usable. Because the ERS handles highly sensitive data as periodical keys, the ‘539 system separates ERS components into two or more computing platforms to protect the data. The first platform which may be publicly accessible over the Internet for example, handles non-secure processing of information related to ECM retrofitting process while the second platform is physically separated to handle secure processing.

The ‘539 application is silent about checking whether the first secret code S_m has previously been stored in the slave terminal, when the first secret code S_m has previously been stored in the slave terminal, checking whether the first secret code S_m is in a biunique relationship with the second secret code S_s, when the first secret code S_m has not previously been stored in the slave terminal, inviting said user to enter the first secret code S_m in said slave terminal, and checking whether the first secret code S_m entered by the user in the slave terminal is in a biunique relationship with the second secret code S_s, authorizing the reception

of the scrambled data and/or services by the slave terminal, when the first secret code S_m is in a biunique relationship with the second secret code S_s, and prohibiting the reception of the scrambled data and/or services by the slave terminal, when the first secret code S_m is not in a biunique relationship with the second secret code S_s.

All claim limitations must be considered when analyzing the non-obviousness of an invention.⁶ In the present case, even if the combination of the '563 and '539 applications is assumed to be proper, the combination fails to disclose the claimed invention. Thus, no matter how the teachings of the '563 and '539 applications are combined, the combination does not teach or suggest the checking, inviting, authorizing, and prohibiting steps defined in Claim 11 .

Further, there is no apparent reason to modify the '563 method so as to arrive at Applicant's claimed inventions. The position that the '563 method *could* be modified to arrive at the claimed inventions would be insufficient to establish a *prima facie* case of obviousness. It is not clear how such modification could be achieved without a substantial reconstruction or redesign of the '563 method.⁷

Accordingly, it is respectfully submitted that Claims 12-14 patentably define over any proper combination of the '563 and '539 applications.

Regarding the rejections of dependent Claims 15-17 under 35 U.S.C. § 103(a), it is respectfully submitted that the '732 patent fails to remedy the deficiencies of the '563 application, as discussed above. Accordingly, it is respectfully submitted that Claims 15-17 patentably define over any proper combination of the '563 application and the '732 patent.

⁶ See MPEP 2143.03

⁷ See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

Amended Claim 18 is directed to a scrambled data and/or service distribution system for at least one master terminal and at least one slave terminal, each equipped with a security processor, the system comprising:

a central subscriber management module;

an entitlement management message generator;

a scrambling platform;

means for attributing to the master terminal a first secret code S_m , and to each slave terminal a second secret code S_s ;
and

control means for authorizing reception of the data and/or services by a slave terminal only when the first secret code S_m is previously stored in the slave terminal and when the first secret code S_m entered in the slave terminal is in a biunique relationship with the second secret code S_s .

Regarding the rejection of Claim 18 under 35 U.S.C. § 103(a), as noted above, the ‘563 application fails to disclose the checking, inviting, authorizing, and prohibiting steps of Claim 11. Thus, the ‘563 application fails to disclose the control means of Claim 18.

Further, it is respectfully submitted that the ‘732 patent fails to remedy the deficiencies of the ‘563 application, as discussed above. The ‘732 patent is directed to a pay TV method and device which comprises master and slave decoders. In particular, the ‘732 patent discusses a master decoder for use with a master smart card and at least one slave decoder for use with a slave smart card are arranged in a pay TV system, in which the master decoder receives slave entitle messages from a central management device and writes the slave entitlement messages to the slave smart cards when the slave smart cards are inserted in the master decoder.⁸ The ‘732 patent does not disclose that the system includes control means for authorizing reception of data and/or services by the slave decoder ***only when a first secret code S_m is previously stored in the slave decoder and when the first secret code S_m entered in the slave decoder is in a biunique relationship with a second secret code S_s .***

⁸ See ‘732 patent, Abstract.

Thus, no matter how the teachings of the '563 application and the '732 patent are combined, the combination does not teach or suggest the control means of Claim 18. Accordingly, it is respectfully submitted that Claim 18 (and all associated dependent claims) patentably defines over any proper combination of the '563 application and the '732 patent.

CONCLUSION

Thus, it is respectfully submitted that independent Claims 11 and 18 (and all associated dependent claims) patentably define over any proper combination of the '563 application, the '539 application, and the '732 patent.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

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